

REMARKS

Review and reconsideration on the merits are requested.

Formalities

Applicants appreciate the Examiner acknowledging receipt of certified copies of the priority documents (there is one priority document), returning initialed PTO/SB/08 (filed September 1, 2006) and providing PTO-892.

Claims Pending at the Time of Action

Claims 1-22, 37-31; claims 23-26 and 32-34 were canceled.

Claim Rejections - 35 U.S.C. § 112

With respect to the rejection under the second paragraph of 35 U.S.C. § 112, Applicants follow the order of the Examiner.

On line 9 of claim 1, "substituents group □" is corrected to --substituent group α--.

Claims 11-16, 18 and 28 are canceled.

Regarding claims 10, 17 and 27, Applicants include "therapeutically effective amount" into claim 10 as suggested by the Examiner. Claims 17 and 27 depend from claim 10.

Withdrawal is requested.

Claim Rejections - 35 U.S.C. § 112

This rejection is posed under the first paragraph of 35 U.S.C. § 112.

With respect to the prodrugs not being enabled, prodrugs are canceled from all claims.

Claim Rejections - 35 U.S.C. § 112

This particular rejection is a lack of enablement regarding claims 19-22 and 27-31, the Examiner urging that the specification lacks enablement of the term "disease associated with

hyperglycemia.” The Examiner admits that the specification is enabling for “plasma glucose concentration for diabetic rat model”, but, in the Examiner’s view, it is not seen where this enables other types of diseases associated with hyperglycemia.

The present specification discloses that the compounds of the present invention have an SGLT 1 and/or 2 inhibitory effect *in vitro* as shown in Table 16 and 17, and, as a result, can lower the plasma glucose concentration *in vivo* as shown in Table 18. Based on these findings, the specification also explains that the compounds of the invention should be useful as an agent for the prevention or treatment of a disease associated with hyperglycemia such as diabetes, impaired glucose tolerance, diabetic complications, obesity, hyperinsulinemia, hyperlipidemia, hypercholesterolemia, hypertriglyceridemia, lipid metabolism disorder, atherosclerosis, hypertension, congestive heart failure, edema, hyperuricemia and gout (see from at page 76, line 18 to page 77, line 16). See claim 21 and new claim 35.

Since it is clear that "disease associated with hyperglycemia" can be treated by lowering the plasma glucose concentration, that is, improving hyperglycemia, Applicants submit that it is predictable for one skilled in the art and one skilled in the art would accept that the present nitrogen-containing fused-ring derivatives also can be useful for the treatment of a disease associated with hyperglycemia other than diabetes based on the teaching provided by the specification. As such a disease, the above-illustrated diseases such as diabetes, impaired glucose tolerance, etc., are well known to one skilled in the art.

Applicants thus respectfully submit that one of ordinary skill in the art would, in fact, have found the data in the specification to provide adequate enablement for other types of “disease associated with hyperglycemia”, and request withdrawal.

Paragraph 8 at Page 9 of the Action

Applicants cancel “preventing” language from the claims, avoiding the enablement rejection that while the specification, being enabling for treating specific diseases, does not reasonably provide enablement for preventing diseases.

Miscellaneous

Applicants question as to why at page 8 of the Action third full paragraph, the Examiner has mentioned “treating tumor disease” since this is not listed as one of the Examples of “disease associated with hypoglycemia”.

Request for Telephone Interview

Applicants request a telephone interview to discuss with the Examiner the allowability of claims such as claims 20, 21, 30 and 35. A brief telephone interview was conducted with the Examiner as to whether claim 21 (now claim 35) might be allowable, the Examiner stating that she did “not remember the Action” and that Applicants should “file a response”.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
Application No.: 10/591,757

Attorney Docket No.: Q96646

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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Date: October 19, 2007